

DETAILED ACTION

Response to Amendment
No claims have been amended.

Claims 1-32 are pending examination.

Response to Arguments

I. In view of the Appeal Brief filed on 4/03/2008, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is a non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendment, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

II. Applicant's arguments with respect to claims 1, 8, 11, 18, 21 and 24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101 Utility

III. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

IV. **Claims 8-10, 18-20 and 24-25** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The systems described in the above claims comprise “means” which are directed to software implementations, thus rendering the systems as software systems with no hardware presence. Therefore the above claims are non-statutory unless embodied on a computer-readable storage medium or implemented by hardware elements.

Claim Rejections - 35 USC § 102

V. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

VI. **Claims 1-4, 8, 11, 16-18, 21, 24 and 29** are rejected under 35 U.S.C. 102(e) as being anticipated by *deBry et al* (US 6,538,760).

a. **Per claims 1 and 8** (differs by statutory subject matter), *deBry et al* teach a method for facilitating generation of a hard copy, comprising:

- selecting a document file written in a first language (*col.5 lines 8-16*);

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- selecting a translator configured to translate the document file into a second language of specialized commands for a hard copy generation device, the specialized commands enabling a hard copy of the document file to be produced at the hard copy generation device (*col.5 lines 30-39, col.9 lines 23-30—commands for resources and control information for the printer*); and
- packaging the document file and the translator file together in a job package that can be received by the hard copy generation device (*col.5 lines 16-45 and 46-60, col.7 lines 30-43, col.8 lines 14-42—container of commands and control information sent to printer*).

b. **Per claims 11 and 18** (differs by statutory subject matter), *deBry et al* teach a method for generating a hard copy, comprising:

- receiving a job package comprising a document file representing a document, the document file written in a first language, and a translator configured to translate the document file into a second language of specialized commands for producing a hard copy of the document file at a hard copy generation device (*col.5 lines 30-39, col.6 lines 3-67, col.8 lines 46-67, col.9 lines 23-30—commands for resources and control information for the printer, and cross reference table with location information for data stream to be printed*);
- opening the job package (*col.9 lines 9-20*);
- using the translator to translate the document file into the second language (*col.5 lines 30-39, col.9 lines 23-30*); and
- generating a hard copy of the document (*col.5 lines 16-45 and 46-60, col.7 lines 30-43, col.8 lines 14-42—container of commands and control information sent to printer*).

c. **Claims 21 and 24** contain limitations that are substantially similar to claims 1, 8, 11 and 18 and are therefore rejected under the same basis.

d. **Per claim 2**, *deBry et al* teach the method of claim 1, wherein selecting a document file comprises selecting a document file identified by a user (*col.5 lines 8-14*).

e. **Per claim 3**, *deBry et al* teach the method of claim 1, wherein the step of selecting a translator comprises selecting a translator identified by a user (*col.5 lines 16-54*).

f. **Per claim 4**, *deBry et al* teach the method of claim 1, further comprising the step of transmitting the job package to the hard copy generation device (*col.5 lines 16-45 and 46-60, col.7 lines 30-43, col.8 lines 14-42*).

g. **Claim 29** is substantially similar to claim 4 and is therefore rejected under the same basis.

h. **Per claim 16**, *deBry et al* teach the method of claim 1, further comprising the step of registering with a remote computing device prior to generating the hard copy (*col.5 lines 40-60; print server*).

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i. **Per claim 17**, *deBry et al* teach the method of claim 16, wherein the step of generating a hard copy is enabled by the remote computing device (*col.5 lines 40-60, col.7 lines 44-56*).

Claim Rejections - 35 USC § 103

VII. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

VIII. Claims 5, 22 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *deBry et al* (US 6,538,760) in view of *Vidyanand* (US 6,967,728).

a. **Per claim 5**, *deBry et al* teach the method of claim 1, yet fails to explicitly teach the step of transmitting the job package to a recipient computing device. However *Vidyanand* teaches transmitting the printer driver and file to another user computer in addition to a printing device (*col.2 line 63-col.3 line 3, col.4 lines 46-55, col.5 lines 16-22 and 28-36, col.8 lines 5-55*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *deBry et al* and *Vidyanand* for the purpose of allowing printing preferences to be exchanged and transferred across the network from one computer to another.

b. **Claims 22, 25 and 27** is substantially similar to claim 5 and are therefore rejected under the same basis.

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c. **Per claim 26**, *Vidyanand* teach the method of claim 1, further comprising transmitting the job package over a network as an email attachment (*col.4 lines 56-58*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *deBry et al* and *Vidyanand* for the purpose transmitting the job package over the network using electronic communication means.

IX. Claims 6, 7, 9, 10, 12-15, 19, 20, 23, 28, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over *deBry et al* (US 6,538,760) and *Vidyanand* (US 6,967,728) in further view of *Adamske et al* (US 6,615,234).

a. **Per claim 6**, *deBry et al* teach the method of claim 1 as applied above, yet fails to explicitly teach method of claim 1, further comprising the step of encrypting the job package. However, *Adamske et al* disclose encryption of the translated document prior to delivery (*col.3 line 64-col.4 line 8*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *deBry et al* with *Adamske et al* for the purpose of provisioning security and the integrity of the document through the network by implementing encryption.

b. **Claims 9, 12 and 28** are substantially similar to claim 6 and are therefore rejected under the same basis.

c. **Per claim 32**, *deBry et al* teach the method of claim 21 as applied above, yet fails to explicitly teach the method of claim 21, wherein receiving an address comprises receiving a universal resource locator (URL) that identifies the location of the job package. However, *Adamske et al* disclose use of a URL for locating the document. *Adamske et al* teach encryption, and it is therefore intrinsic and obvious (in order to achieve effective communication) to

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provision a method of decryption along with encryption, in order for the document/data to be comprehensible to the appropriate recipient. Furthermore, *Adamske et al* restrict access to the encrypted documents by implementing security features with electronic signatures, pass phrases and user IDs that prohibit access of the document until authentication of the signatures, wherein the document will be decrypted for receipt and viewing once the authentication has been satisfied (*col.6 lines 1-23 and col.8 line 24-col.9 line 32*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *deBry et al* with *Adamske et al* for the purpose of provisioning a decryption method along with an encryption method for making content accessible to the recipient and to furthermore utilize URLs as locators for documents, since URL provide access to electronic documents, data and media on the web/Internet.

d. **Claims 7, 10, 13-15, 19, 20, 23 and 30** contain limitations that are substantially similar to claim 32 and are therefore rejected under the same basis.

X. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over *deBry et al* (US 6,538,760) and *Vidyanand* (US 6,967,728) and in further view of *Nakamura et al* (US 6,064,836).

Per claim 31, *deBry et al* and *Vidyanand* teach the method of claim 16 as applied above, yet fail to explicitly teach the method of claim 16, wherein registering comprises registering with a remote computing device for the purpose of determining whether a total number of hard copies have already been generated and, if so, prohibiting generation of a further hard copy. However, *Nakamura et al* teach the determination of the number of generated copies and the prohibition of addition hard copies being made (*col.1 line 40-col.2 lines 10, col.4 lines 25-51, col.6 lines 31-67*,

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col.7 line 41-col.8 line 12, col.9 line 66-col.10 line 60, col.11 lines 48-56, col.12 lines 52-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *deBry et al* and *Vidyanand* with *Nakamura et al* with for the purpose of provisioning monitoring/tracking of the number of hard copies generated/printed in order to properly process the document/data in its entirety; because it allows for management of hard copy generation.

Conclusion

XI. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure: Chatcavage et al (6992785), Downs et al (6067553), Ishikawa et al (5987226), Stone et al (5982997).

Examiner's Note: Examiner has cited particular columns and line numbers in the reference(s) applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the Applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the cited passages as taught by the prior art or relied upon by the examiner. Should Applicant amend the claims of the claimed invention, it is respectfully requested that Applicant clearly indicate the portion(s) of Applicant's specification that support the amended claim language for ascertaining the metes and bounds of Applicant's claimed invention.

XII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie D. Shingles whose telephone number is 571-272-3888.

The examiner can normally be reached on Monday 8:00am-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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